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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/983,041	10/22/2001	Atsushi Shibuya	PF-2894/NEC/US/mh	8200
30743	7590	07/13/2005	EXAMINER	
WHITHAM, CURTIS & CHRISTOFFERSON, P.C. 11491 SUNSET HILLS ROAD SUITE 340 RESTON, VA 20190			SHAH, KAMINI S	
			ART UNIT	PAPER NUMBER
			2142	

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/983,041

Applicant(s)

SHIBUYA, ATSUSHI

Examiner

Kamini S. Shah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments, see amendment, filed 4/18/05, with respect to the rejection(s) of claim(s) 1-55 under 35 USC 102 (2) as being anticipated by GB 2356956 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of EP 0866586. Applicant's amendment has not overcome the 112 second paragraph rejection as disclosed below.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 1, 16, 29, 38 and 47 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claimed proposed invention, as a whole, which here refers to the common subject matter of independent claims, is not clearly defined. In claim 38, which appears to be the broadest claims and recites the common subject matter of all independent claims, it is not clear what is meant by the "retrieval of information" or "retrieval condition". In the context of the embodiment of the invention, is the "information" that is retrieved an email, or a keyword in an email, or a section of the email in which to look for keywords, or an indication from the email that a keyword is present in the email, or a

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keyword retrieved from a keyword table, or something else? Further, does the "retrieval condition" put conditions on the way the "retrieval of information" is conducted, or is it some other condition that is retrieved (in which case it is poorly named)? These uncertainties cast doubt on the scope of the invention and so a full examination of claimed invention is not possible until claims are amended to clearly define the invention.

4. Claim 1, 10-14 recites the limitation "said terminal device" in lines 10-11. There is insufficient antecedent basis for this limitation in the claim. Claim 1 defines "a plurality of terminal devices" but there is no definition of a single "terminal device" providing antecedent basis for "said terminal device".

In claim 35, there is no antecedent basis for "said communication unit"

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-55 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by EP 0866586, cited by applicant.

Regarding to claimed invention as best understood, EP 0866586 clearly discloses messaging system connected to electronic mail control section inherently

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including processing unit for transferring and receiving information – e-mail. A Display Application section 16 connected to electronic mail section or can be called as processing unit for displaying information, an operation unit as can be seen as facsimile, pager, telephone for operating terminal device such as portable phone terminal. Regarding claimed features of communication system includes a table which provides at least one retrieval condition and at least one display method, EP 0866586 discloses various software process running on the various servers such as main spool 5 in the mail server 2, the SUBLIST routine 6 searches the main spool 5 for email message containing the specified code, and SUBJ-DB database 4, see page 5, lines 5-14.

Regarding to claims 2-8, and 10-11, EP 0866586 discloses various claimed features in the Display Application 16 including font data table, display of a reception e-mail as claimed displaying information and table including necessary data for displaying information, see page 5, lines 40- 55 and page 6, lines 1-45.

Regarding claims 12 and 13, EP 0866586 teaches first functional block as messaging server performing transmission control and reception control; second function block is disclosed as display application 16 and the input/output section for displaying information corresponding character pattern; third functional block is disclosed as IMP server 3 for carrying out the control of general functions relating to the transmission and reception of the electronic mail, see page 4, lines 27-30.

Regarding claims 14 and 15, EP 0866586 discloses IMP message server 3 having processing unit, memory for storing computer program for storing message in a

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database in the IMP server 3, then displaying on display application 16 in window 16, if the message exits, see pages 4 lines 19-26.

Regarding claims 16-54, claims recite similar subject matter as claims 1-15 therefore rejected for the similar reasoning.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kamini S. Shah whose telephone number is 571-272-2279. The examiner can normally be reached on IFP.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew B. Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Kamini S Shah  
Primary Examiner  
Art Unit 2142

kss